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In re Application of :
FRAMPTON et al. :
U.S. Application No.: 10/507,278 :
PCT No.: PCT/GB03/00942 : DECISION ON PETITION
Int. Filing Date: 06 March 2003 :
Priority Date: 13 March 2002 :
Attorney Docket No.: DYOUP0277US :
For: FABRICATION OF :
MICROSTRUCTURED OPTICAL FIBRE :

This decision is in response to applicants' "Re-submission of Supplemental Reply to Notification of Missing Requirements" filed 09 December 2005 to accept the application without the signature of joint-inventor, Kai Ming Kiang.

BACKGROUND

On 06 March 2003, applicants filed international application PCT/GB03/00942- which claimed a priority date of 13 March 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 25 September 2003. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 13 September 2004.

On 10 September 2004, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a preliminary amendment.

On 28 February 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 01 August 2005, applicants filed a petition under 37 CFR 1.47(a). In a decision dated 08 November 2005, applicants' petition under 37 CFR 1.47(a) was dismissed without prejudice.

On 09 December 2005, applicants filed "Re-submission of Supplemental Reply to Notification of Missing Requirements" which included: a copy of "Supplemental Reply to

Notification of Missing Requirements;" a copy of the declaration and power of attorney filed 18 August 2005; and a post card receipt for application no. 10/507,278 dated 18 August 2005.

DISCUSSION

A.. Petition under 37 CFR 1.181

Applicants state that a declaration and power of attorney was received at the United States Patent and Trademark Office on 18 August 2005. A review of the present application reveals that the declaration and power of attorney filed 18 August 2005 is not located therein. Section 503 of the Manual of Patent Examining Procedure under the heading "RETURN POSTCARD" states, in part:

"A postcard receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO.

The postcard receipt will not serve as prima facie evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt . . .

. . . If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the postcard initialed by the person receiving the items . . .

The copy of the postcard receipt submitted with the petition bearing a date stamp "JC18 Rec'd PCT/PTO 18 AUG 2005" did not clearly itemize the contents being submitted and will not serve as prima facie evidence. The postcard receipt indicates that an IDS/1449/Refs and a Supplemental Reply to Notification of Missing Requirements as being filed. However, the postcard receipt does not indicate that a declaration and power of attorney was submitted on 18 August 2005. The Office procedure for any papers not present in a package that were specifically identified on a postcard receipt is for the postcard to be annotated to indicate that papers were not received. In the present instance, the declaration/power of attorney was not itemized on the postcard, thus, a hand written entry regarding the nonreceipt of PCT Request would not be required under MPEP 503 since the declaration/power of attorney was not identified on the postcard receipt. Hence,

the postcard receipt is not prima facie evidence of what was filed on 18 August 2005 and the declaration cannot be considered as filed on 18 August 2005.

B. Renewed Petition under 37 CFR 1.47(a)

The "Re-submission of Supplemental Reply to Notification of Missing Requirements" filed 09 December 2005 will be treated as a Renewed Petition Under 37 CFR 1.47(a). As stated above, in a decision dated 28 October 2004, applicants' petition under 37 CFR 1.47(a) to accept the application without the signature of joint inventor, Kai Ming Kiang, was dismissed without prejudice.

The petition for status under 37 CFR 1.47(a) is moot since the declaration filed 09 December 2005 with the present renewed petition was executed by the named inventor, the previous non-signing inventor, Kai Ming Kiang. The declaration is acceptable under 37 CFR 1.497. For the reasons above, the renewed petition under 37 CFR 1.47(a) is **DISMISSED** as **MOOT**.

C. Request for Refund under 37 CFR 1.26

Applicants request a refund of the \$200 petition fee submitted on 01 August 2005. Applicants state in the present submission that the duly executed declaration executed by the previous nonsigning inventor was submitted on August 16, 2005 and this rendered the petition under 37 CFR 1.47(a) as moot. 37 CFR 1.26(a) states that the Director may refund any fee paid by mistake or in excess of that required. In this case, the payment of the petition fee cannot be considered as a fee paid by mistake or in excess since the petition was considered a response to the Notification of Missing Requirements mailed 28 March 2005. Therefore, a refund of the petition fee would not be proper.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 is **DISMISSED** without prejudice. The renewed petition under 37 CFR 1.47(a) is **DISMISSED** as **MOOT** and the request for refund under 37 CFR 1.26 is **DISMISSED** without prejudice.

The application has an international filing date of 06 March 2003 under 35 U.S.C. 363 and a date of **09 December 2005** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

The application is being returned to the International Division for processing as the U.S. National Stage of the above-identified international application.

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